IV.   Remarks

A.   Drawing Objection

In the Action, the Examiner objects to the drawing Figures 2-11 as being too dark. The Applicants have submitted formal drawings of Figures 1-11 with this Response. It is submitted that the formal drawings address all of the Examiner's concerns. Withdrawal of the drawing objection is respectfully requested.

B.   Amendments

Paragraph 18 of the Specification has been amended to insert the serial number of the referenced application.

Paragraph 24 has been amended to correct a typographical error, i.e., to provide the word "of" between "800" and "FIG. 8".

Independent Claims 1, 14, 24 and 33 have been amended to clarify that the "map display" is displayed by a user terminal, rather than "on a computer". Applicants submit that the use of the terminology "user terminal" is consistent with the description at Paragraphs 10 and 12 of the Specification, which describe various types of "user terminals."

C.   Rejection under 35 USC 102(b)

The Action rejects Claims 1-40 as being anticipated by Microsoft's MapPoint as evidenced by two articles: "Divide and Conquer" and "Microsoft MapPoint 2000 Delivers New Mapping and Analysis Program". Reconsideration and withdrawal of this rejection are respectfully requested.

In rejecting independent method Claims 1 and 14, the Examiner provides the following reasoning:

> While MapPoint does not explicitly teach the system being used
> for analysis of lottery retailers, these limitations <u>merely recite</u>

various intended uses of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art.

(emphasis added)(citations omitted).

While the Applicants do not doubt that the Examiner's citation of the law is accurate, Applicants' respectfully submit that the Examiner's support does not apply to Applicants' method claims. It is fundamentally true that merely reciting an intended use of a structure does not distinguish a claimed **structure** from an **anticipating prior art structure**. However, Claims 1 and 14 are method claims. The recited methods are affirmative recitations of individual steps, not merely an intended use of a structure, and must be examined as such.

It is black letter patent law that new uses for old structure may be patentable when recited as methods. For example, a claim directed to an existing (i.e., prior art) compound is not patentable (whether the claim recites an intended use or not), but the use of the compound in a new process may be patentable.

Likewise, the Examiner's reliance on lack of a "manipulative difference" in a process of making is misplaced, as Applicants do not claim a process of making anything.

Accordingly, Applicants method claims 1 and 14 must be Examined by comparing **the recited steps** against the prior art. With respect to Claim 1, the prior art cited by the Examiner does not teach the step of assigning unique identifiers to a plurality of "lottery retailers", the unique identifiers indicating types of lottery games sold by respective lottery retailers, nor does it

teach the step of identifying respective locations "of lottery retailers from the plurality of lottery retailers" on a map display displayed by a user terminal using the unique identifiers. There is simply no teaching in the references of steps performed by MapPoint (or any other software) respective to lottery retailer data and game type. For at least these reasons, it is submitted that the Examiner has not presented a *prima facie* case of anticipation. See MPEP 2131.01 ("A claim is anticipated only if <u>each and every element</u> as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.") (emphasis added)

Therefore, it is submitted that Claims 1 and 14, and Claims 2-13 and 15-23, which depend therefrom, are allowable over the art of record. Reconsideration and withdrawal of this rejection are respectfully requested.

The Examiner rejects Claims 24 and 33, which are directed to computer-implemented systems for processing lottery sales data, as being anticipated by applying the rejections of the method claims and further stating that MapPoint is computer implemented. This reasoning would apply if Applicants were merely claiming a computer system having mapping software thereon, which is not the case.

Claims 24 and 33 are directed to systems specifically configured for lottery retailer, game type and sales data. A computer system having MapPoint thereon alone would not provide: (a) means for assigning unique identifiers <u>to a plurality of lottery retailers</u>, said unique identifiers indicating <u>types of lottery games sold by respective lottery retailers</u> from said plurality of lottery retailers; and (b) means for identifying on a map display displayed by a user terminal using said unique identifiers <u>respective locations of lottery retailers</u> from said plurality of lottery retailers, as claimed in Claim 24, for example. By way of example, in one embodiment, a means for assigning unique identifiers to a plurality of lottery retailers would utilize specific graphical user interfaces specifically configured for lottery retailer data and lottery game type data. This means is certainly not provided by off-the-shelf MapPoint. The software must be specifically configured, as Applicants have done through significant efforts.

In a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, or the like, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm. See WMS Gaming Inc. v. Int'l Gaming Tech., 184 F.3d 1339, 1349 (Fed. Cir. 1999). It is submitted that Applicants' recited means correspond to specially programmed structure, which is not anticipated by a computer programmed with generic MapPoint software.

It is submitted, therefore, that the Examiner has not set forth a *prima facie* case of anticipation, and that Claims 24 and 33, and Claims 25-32 and 34-40, which depend therefrom, are allowable over the art of record. Reconsideration and withdrawal of this rejection are respectfully requested.

V.   Conclusion

In view of the foregoing remarks and amendments, Applicants submit that this application is in condition for allowance at an early date, which action is earnestly solicited.

The Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to deposit account **04-1679**.

Respectfully submitted,

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